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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,016	01/25/2002	Theodore Tuimasella	54530-00002	3598

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EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2161

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,016

Applicant(s)

TURNASELLA, THEODORE

Examiner

Susan Y. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response To Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/2006 has been entered.

Claims 1-31 are pending for examination, claims 20, 28-31 have been amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,741,993 issued to Zitaner et al. (hereinafter referred as '993) in view of U.S. Patent No. 6,401,079 issued to Kahn et al. (hereinafter referred as '079)

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As to claims 20, the '993 patent discloses a system for providing survey data from members of a survey group via an internet [e.g., Abstract, Fig. (s) 1-4], comprising:

a) a database for storing salary data [e.g., the unit 10, Fig. 1];

b) a server [e.g., the Reward Workbench (60), Fig. 1] providing access to the Internet, wherein the server configured to:

accepting salary data to the salary survey service [e.g., the 1st step of Fig. 3 wherein the row data elements including participant's and salary data at shown in Fig. 4] ;

storing the salary data received from the at least a portion of the participants in the database [e. g., the 4th step of Fig. 3];

grouping the plurality of participants into survey group by the portion of the plurality of participants [e.g., the 2nd step of Fig. 3];

generating a salary survey for participants of the survey group using the stored data provided by the participants of the survey group [e.g., col. 6, lines 23-33]

providing access to the salary survey via the internet [e.g., Abstract, lines 8-10, the Data Network, Fig. 2].

The '993 patent did not specifically disclose aging salary data for at least a portion of stored salary data;

However, the '079 patent disclosed the claimed feature [e.g., the effective date, expiration date attributes of the Pay Scales table 435, Fig. 4].

The '993 and '079 patents are both in the same endeavor for efficiently survey salary information, thus, with the teachings of '993 and '079 in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify the salary information of '993 system with aging attributes as taught by '079 patent, because by doing so, the combined system will be upgraded to provide more details information for the pay scale survey and calculation.

As to claim 21, except all the features recited in claim 20, the combined system of '993 and '079 patents further discloses that the survey are group by at least one of the business organization or others [e.g., '993: col. 1, lines 14-22].

As to claims 22-25, except all the features recited in claim 20, the combined system of '993 and '079 patents further discloses that the members including individuals, companies, trade associations, contributor and subscriber [e.g., '993: col. 1, lines 26-35].

As to claims 26-27, except all the features recited in claim 20, the combined system of '993 and '079 patents further discloses that the server is further configured to receive designations of the members to be included in the survey group and parameters

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to defining information to be presented by the survey [e.g., '993: the first three steps of Fig. 3; Figure 4 and associated texts].

As to claims 28-29, except all the features recited in claim 20, the combined system of '993 and '079 patents further discloses that the server is configured to provide access to the plurality members of the survey group [e.g., '993: the units 30, 32, 34, 36, Fig. 1].

As to claim 30, except all the features recited in claim 20, the combined system of '993 and '079 patents further discloses that the salary data is related to job positions [e.g., '993: the Job_code, Position fields, Fig. 4].

Claim Rejections - 35 USC § 103 (continue)

As to claim 31, the combined method of '993 and '079 patents did not specifically disclose that the salary data is aged by an annual growth rate.

However, Official Notice is taken that aging salary data by an annual growth rate is well-known and expected in the art, therefore, it would have been obvious to one of ordinary skill person in the art at the time the invention was made to include this well known features in the combined method of '993 and '079 patents, for the purpose of facilitate the calculation of annual wage.

As to claims 1-19, the steps in the claimed method are deemed to be made obvious by the functions of the apparatus structure of claims 20 - 30 in the combination discussed above, hence were rejected for the same reasons.

Response to Arguments

Applicant's arguments filed on 8/17/2006 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, the Office points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the examiner disagrees with applicant's arguments that "Zitaner collects data on a regular basis, there is absolutely no motivation for a person of ordinary skill in the art to age the data collected by the system disclosed by Zitaner."

In reply to these arguments the examiner points out just because the data is collected by the system on a regular basis, thus it is obvious for an ordinary skilled artisan to associate an age to the collected data, such that the system can use the aged data to verify if the data is collected regularly or not.

Furthermore, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same

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use." *In re Gurley*, 27 F.3d 551, 554, 31 USPO2d 1130, 1132 (Fed. Cir. 1994), (MPEP 2145 X.D.1) Claims 1 and 20 are direct to survey salary data, the claim would have been obvious over the prior art because the combined references teach the same features as claimed and was useful for the same purpose. Furthermore, applicant did not distinguish the claimed subject matter from the method taught in the combined prior art, and applicant asserted no inventive features beyond what was known to the art, as such, the 35 USC 103(a) rejections are maintained.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen
Examiner
Art Unit 2161

October 23, 2006

[Handwritten signature]
App. No. 10/057,016
Primary Examiner
TC 2161